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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/509,337	06/13/2000	TORLEIF OVE BJORNSON		1608

7590 04/09/2003
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EXAMINER

LUDLOW, JAN M

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 04/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/509,337

Applicant(s)

BJORNSON ET AL.

Examiner

Jan M. Ludlow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The disclosure is objected to because of the following informalities: The statement of priority is unclear. PCT/US98/21869 is a continuation-in-part of US Application Serial No. 08/950403.

Appropriate correction is required.

Note that in the instant application, claims supported by pages 1- 33, line 7 have an effective filing date of October 15, 1997, whereas claims supported by page 33, line 8 - end have an effective filing date of October 15, 1998.

2. No PTO form 1449 filed May 24, 2000 has been found in the file wrapper. Applicant is requested to resubmit a copy of form 1449 along with any non-patent references not of record in 08/950403 associated with the form 1449 filed May 24, 2000.
3. Claims 41-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 41, and 48, "being fed from" is unclear because it recites a method step and is therefore not a clear structural limitation. In claim 26, "said film" lacks clear antecedence because "films" have previously been recited.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parce '470.

Parce '470 teaches a microfluidic electroosmotic device having two or more parts. A first planar element has channels molded or embossed therein (col. 5, line 21) and a second planar element is bonded to the first element to cover the channels (col. 6, lines 1-21). Plural devices may be made simultaneously by embossing/molding substrate sheets (col. 5, lines 24-26). The elements are polymeric and may be non-rigid (col. 6, line 23), constituting the instant films. The device is elongate and has a network of channels as shown in Figure 2. Electrodes may be provided on the elements (col. 10,

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lines 30-31) and coatings may be provided to change the electrical characteristics of the elements (col. 8, lines 22-29).

Parce '470 fails to explicitly teach a film, an electrode on the second planar element/film, or a "release liner."

It would have been obvious to make the device of Parce from non-rigid (flexible) polymers, constituting the instant films, in order to make a non-rigid element for suitable uses as taught by Parce '470. It would have been obvious to locate an electrode on either film element in order to contact the fluid contained therein as taught by Parce '470. It would have been obvious to provide a coating (instant release liner) in order to change the characteristics of the film as taught by Parce '470. It is the examiner's position that the coatings taught and/or suggested by Parce constitute the instant release liners because applicant has defined release liners as layer preventing evaporation or light damage, and it is the examiner's position that the layers taught or suggested provide such function by, e.g., opacity and provision of a mass transfer barrier.

8. Claims 41-47, 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parce '470 as applied to claims 22-25 above, and further in view of Parce '071.

Parce '470 fails to teach providing the flexible sheets of plural devices on a roll.

Parce '071 teaches that flexible matrices can be folded or rolled for storage and handling (col. 13, lines 25-30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the sheets of flexible devices of Parce '470 on a roll in

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order to provide ease of storage and handling as taught by Parce '071. With respect to specific polymers, it would have been obvious to use known polymers for their known properties.

9. Claims 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parce '470 and Parce '071 as applied to claims 11-17, 22-26 above, and further in view of Ekstrom et al

Parce '470 fails to teach that the two or more elements constitute the three films as claimed.

Ekstrom teaches a device similar to that of Parce '470 and Parce '071.

Microchannels can be formed either partially through or entirely through (i.e., as slits) in a layer intermediate a support and a cover (col. 3, lines 20-30).

It would have been obvious to form the channels in the first substrate of Parce '470 and Parce '071 as slits between the second substrate and cover in order to form a channel in a microfluidic device as a known alternative to a cavity extending partially through an intermediate layer as taught by Ekstrom.

10. Applicant's arguments with respect to claims 41-56 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan M. Ludlow whose telephone number is (703) 308-4039. The examiner can normally be reached on Monday-Thursday, 11:30 am - 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (703) 308-4037. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Jan M. Ludlow

Primary Examiner

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jml

April 7, 2003